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09/910,709	07/24/2001	Chang Kwon Lee	P-0236	1806

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EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/910,709

Applicant(s)

LEE ET AL.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 24, 28, 29, 33, 38, 39 and 46-48 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-23, 25, 26, 40, 49, 58 and 59 is/are allowed.
- 6) ☒ Claim(s) 27, 30-32, 34-37, 41-45, 50-57 and 60-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/27/2007.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 30, 32, 34-36 and 45 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hori et al, U.S. Patent No. 6,792,280 (hereinafter Hori).

Regarding claim 30, Hori discloses a method of transmitting a compressed digital data file (see music data from abstract), comprising:

receiving information from a first terminal (see unit 12 from Figure 6) identifying a second mobile terminal (see unit 14 from Figure 6), said information including a telephone number of the second mobile terminal;

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receiving information (see Desired music data from column 19) from the first terminal selecting a compressed data file from a compressed data file list;

transmitting a guide message (see coupon from column 23) including data for identifying the selected compressed data file to the second mobile terminal based on the telephone number of the second mobile terminal, the data for identifying having file information of the compressed digital data, and

transmitting (see download process from column 23) the compressed data file to the second mobile terminal in response to a signal (see a coupon is transmitted to the download server from column 23) received from the second mobile terminal requesting the compressed data file.

Regarding claim 32, see column 15.

Regarding claim 34, see column 15.

Regarding claim 35, see column 13.

Regarding claim 36, see column 13.

Regarding claim 45, Hori discloses a method for transmitting a compressed digital data file (see MIDI, MPEG, Audio from column 17), comprising:

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providing an input window on a first terminal (see unit 12 from Figure 6) for inputting information of a second mobile terminal (see unit 14 from Figure 6) including a telephone number of the second mobile terminal, wherein the input information being provided to the first terminal with information identifying a source of the digital data file, and

selecting at least one digital file from a file list (see list of music data from column 18) to be transmitted, where a title name (see coupon from column 23) of the selected data file is separately transmitted with the selected digital data file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 27 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hori in view of Rolf, U.S. Patent No. 7,065,342 (hereinafter Rolf).

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Regarding claim 27, Hori discloses a digital data transmitting/receiving terminal (see Figure 7), comprising:

- a display (see unit 40 from Figure 7) for outputting visual digital data;

- a compressed digital data outputting circuit (see unit 46 from Figure 7) for outputting compressed digital data;

- a key pad (see unit 44 from Figure 7) for generating input digital data according to a user's input command;

- a memory (see unit 58 from Figure 7) for storing digital data;

- a wireless transmitting/receiving circuit (see unit 32 from Figure 7) for transmitting and receiving digital data; and

- a controller (see unit 36 from Figure 6) for controlling flow of the digital data,

wherein the controller includes a data discriminating function to discriminate whether the digital data received by the wireless transmitting/receiving circuit includes recognition data (see coupons from column 18) having a file information of the compressed digital data, wherein the recognition data and the corresponding compressed digital data (see MIDI, MPEG, Audio from column 17) are separately transmitted/received,

wherein the recognition data includes a synchronization code informing transmission of a compressed digital data and a

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type, and name (see music identification code from column 19) of the data file; and

wherein the controller receives (see s91 from Figure 16) the recognition data in a guide message before the compressed digital data is received, the guide message asking whether the user would like to receive the compressed digital data, and

wherein the controller controls transmission (see s105 from Figure 17) of a first request signal in response to the guide message indicating that the user would like to receive the compressed digital data from a first server.

Still on the issue of claim 27, Hori fails to teach the controller further controlling transmission of a second request signal to receive the compressed digital from a second server which stored the compressed digital data during a time when the terminal was in an unavailable state. Regardless, Rolf discloses covers this limitation (see column 7). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the controller further controlling transmission of a second request signal to receive the compressed digital from a second server which stored the compressed digital data during a time when the terminal was in an unavailable state as taught by Rolf. This

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modification would have improved the system's reliability by accounting for circuit irregularity or memory insufficient capacity as suggested by Hori (see column 15).

Again on the subject of claim 27, the combination of Hori and Rolf does not teach the recognition data includes the capacity of the data file. "Official Notice" is taken that this limitation is both old and well known in the art. And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the data for identifying includes the capacity of the data file. This modification would have improved the system's convenience by producing coupons based on the delivery information as suggested by Hori (see column 4).

Regarding claim 37, Hori discloses a digital data terminal comprising:

- a compression digital circuit (see unit 46 from Figure 7) to provide compressed digital data;

- a memory (see unit 58 from Figure 7) to store compressed digital data;

- a wireless transmitting/receiving circuit (see unit 32 from Figure 7) to transmit and receive digital data; and

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a controller to control a flow of digital data, wherein the controller determines whether recognition data (see coupons from column 18) has been received to recognize a compressed data file, the recognition data and the corresponding compressed data file (see MIDI, MPEG, Audio from column 17) being separately transmitted/received; and

wherein the recognition data includes a synchronization code informing transmission of a compressed digital data file and a type, and name of the data file (see music identification code from column 19), and

wherein the controller receives (see s91 from Figure 16) the recognition data in a guide message before the compressed data file is received, the guide message asking whether the user would like to receive the compressed digital data, and

wherein the controller controls transmission (see s105 from Figure 17) of a first request in response to the guide message indicating that the user would like to receive the compressed digital data from a first server.

Still on the issue of claim 37, Hori fails to teach the controller further controlling transmission of a second request signal to receive the compressed digital from a second server which stored the compressed digital data during a time when the

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terminal was in an unavailable state. Regardless, Rolf discloses covers this limitation (see column 7). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the controller further controlling transmission of a second request signal to receive the compressed digital from a second server which stored the compressed digital data during a time when the terminal was in an unavailable state as taught by Rolf. This modification would have improved the system's reliability by accounting for circuit irregularity or memory insufficient capacity as suggested by Hori (see column 15).

Again on the subject of claim 37, the combination of Hori and Rolf does not teach the recognition data includes the capacity of the data file. "Official Notice" is taken that this limitation is both old and well known in the art. And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the data for identifying includes the capacity of the data file. This modification would have improved the system's convenience by producing coupons based on the delivery information as suggested by Hori (see column 4).

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5. Claim 31 is rejected under 35 U.S.C § 103(a) as being unpatentable over Hori.

Regarding claim 31, Hori discloses the data for identifying includes a synchronization code informing transmission of the compressed data file and a type and name of the data file (see coupon including a music identification code from column 19).

Hori doesn't clearly explain that the data for identifying includes the capacity of the data file. "Official Notice" is taken that this limitation is both old and well known in the art. And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the data for identifying includes the capacity of the data file. This modification would have improved the system's convenience by producing coupons based on the delivery information as suggested by Hori (see column 4).

6. Claims 41-43, 50-57 and 60-71 are rejected under 35 U.S.C § 103(a) as being unpatentable over Hori combined with Shanahan, U.S. Patent Application Publication No. 2004/0005880 (hereinafter Shanahan).

Regarding claim 41, Hori discloses a method for receiving and reproducing a digital data file (see music data from abstract) in a device (see unit 14 from Figure 6), comprising:

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receiving (see s91 from Figure 16) first information for identifying the digital file and second information (see message from the requester from column 16), wherein the device is designated by information inputted in a transmitting device by a sender (see unit 12 from Figure 6) which includes the phone number of the device.

Further regarding claim 41, Hori does not disclose checking a format of the digital data file and determining whether to receive the digital data file or not based on whether the checked digital data file has a predetermined format. Nonetheless, Shanahan discloses this feature (see paragraph 0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori with the feature of checking a format of the digital data file and determining whether to receive the digital data file or not based on whether the checked digital data file has a predetermined format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

Again on the issue of claim 41, both Hori and Shanahan fall short of showing that the second information identifies a source

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of the digital data file. "Official Notice" is taken that this limitation is both old and well known in the art. Consequently it would have been obvious to one of ordinary skill in the art to further modify the combination of Hori and Shanahan wherein the second information identifies a source of the digital file. This modification would have improved the system's user friendliness by enabling the sender to input a message as suggested by Hori (see column 13).

Regarding claim 42, see column 19 of Hori.

As per claim 43, neither Hori nor Shanahan disclose that the second information is a sender name or phone number of the transmitting device. "Official Notice" is taken that this limitation is both old and well known in the art. Consequently it would have been obvious to one of ordinary skill in the art to further modify the combination of Hori and Shanahan wherein the second information is a sender name or phone number of the transmitting device. This modification would have improved the system's user friendliness by enabling the sender to input a message as suggested by Hori (see column 13).

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Regarding claim 50, Hori discloses a method for receiving a compressed digital data file, comprising:

displaying a received guide message (see coupons from column 18) and

displaying an identifying message (see message from the requester from column 16) of the compressed digital data file.

Further regarding claim 50, Hori does not disclose checking a format of the digital data file and determining whether to receive the digital data file or not based on whether the checked digital data file has a predetermined format.

Nonetheless, Shanahan discloses this feature (see paragraph 0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori with the feature of checking a format of the digital data file and determining whether to receive the digital data file or not based on whether the checked digital data file has a predetermined format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

Regarding claim 51, see column 19 of Hori.

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Regarding claim 52, Hori does not explicitly mention that the identifying message includes sender and data information. "Official Notice" is taken that this limitation is both old and well known in the art. Consequently it would have been obvious to one of ordinary skill in the art to further modify the combination of Hori and Shanahan wherein the identifying message includes sender and data information. This modification would have improved the system's user friendliness by enabling the sender to input a message as suggested by Hori (see column 13).

Regarding claim 53, see Figure 6 of Hori.

Regarding claim 54, Hori discloses the data information includes format information and sync header information (see s105 from Figure 17). Hori does not explicitly mention the data information includes size information. "Official Notice" is taken that this limitation is both old and well known in the art. Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Hori and Shanahan wherein the data information includes size information. This modification would have improved the system's flexibility by transferring various control information as suggested by Hori (see column 25).

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Regarding claim 55, see column 17 of Hori.

Regarding claim 56, see Figure 16 of Hori.

Regarding claim 57, see s107 from Figure 17.

As per claim 60, Hori does not the predetermined data format is a preset compressed data format. Nonetheless, Shanahan discloses this feature (see paragraph 0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the predetermined data format is a preset compressed data format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

As per claim 61, nowhere does Hori disclose the predetermined data format is an mp3 format. All the same, Shanahan covers this limitation (see paragraph 0029). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the predetermined format is an mp3 format as shown by Shanahan. This modification would have improved the reliability

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of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

As per claim 62, Hori does not disclose the predetermined data format is a preset compressed data format. Nonetheless, Shanahan discloses this feature (see paragraph 0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the predetermined data format is a preset compressed data format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

As per claim 63, nowhere does Hori disclose the predetermined data format is an mp3 format. All the same, Shanahan covers this limitation (see paragraph 0029). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the predetermined format is an mp3 format as shown by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

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Regarding claim 64, Hori discloses a method for receiving a compressed digital data file, comprising:

displaying a received guide message (see coupons from column 18);

displaying an identifying message (see message from the requester from column 16) of the compressed digital data file; and

receiving (see Figure 17) the compressed digital data file.

Further regarding claim 64, Hori does not disclose checking a format of the digital data file and determining whether to receive the digital data file or not based on whether the checked digital data file has a predetermined format.

Nonetheless, Shanahan discloses this feature (see paragraph 0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori with the feature of checking a format of the digital data file and determining whether to receive the digital data file or not based on whether the checked digital data file has a predetermined format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

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Regarding claim 65, see column 19 of Hori.

Regarding claim 66, see column 19 of Hori.

Regarding claim 67, see Figure 16 of Hori.

Regarding claim 68, Hori does not explicitly mention that the identifying message includes information identifying at least one of a sender of the compressed digital data file, a size of the compressed digital data file, or a name of the compressed digital data file. "Official Notice" is taken that this limitation is both old and well known in the art. Consequently it would have been obvious to one of ordinary skill in the art to further modify the combination of Hori and Shanahan wherein the identifying message includes information identifying at least one of a sender of the compressed digital data file, a size of the compressed digital data file, or a name of the compressed digital data file. This modification would have improved the system's user friendliness by enabling the sender to input a message as suggested by Hori (see column 13).

As per claim 69, Hori does not disclose checking whether format of the digital data file is a predetermined format, said predetermined format being a preset compressed data format. Nonetheless, Shanahan discloses this feature (see paragraph

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0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori with the feature of checking whether format of the digital data file is a predetermined format, said predetermined format being a preset compressed data format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

As per claim 70, nowhere does Hori disclose the preset compressed data format is an mp3 format. All the same, Shanahan covers this limitation (see paragraph 0029). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori wherein the preset compressed data format is an mp3 format as shown by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

Regarding claim 71, Hori discloses a mobile terminal comprising:

a first circuit to cause a received guide message (see coupons from column 18) and an identifying message (see message

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from the requester from column 16) of a compressed digital data file (see music data from abstract) to be displayed.

Further regarding claim 71, nowhere does Hori disclose a second circuit to check a format of the digital data file and a third circuit to determine whether or not to receive the digital data file based on whether the checked digital data file has a predetermined data format. Nonetheless, Shanahan discloses these features (see paragraph 0008). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hori with a second circuit to check a format of the digital data file and a third circuit to determine whether or not to receive the digital data file based on whether the checked digital data file has a predetermined data format as taught by Shanahan. This modification would have improved the reliability of Hori by downloading compatible data as suggested by Shanahan (see paragraph 0008).

7. Claim 44 is rejected under 35 U.S.C § 103(a) as being unpatentable over Hori combined with Shanahan in further view of Gold et al, U.S. Patent No. 7,082,469 (hereinafter Gold).

With respect to claim 44, the combination of Hori and Shanahan does not show providing a partial part of the digital

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file to be transmitted, wherein the partial part is a beginning part of the digital data. Regardless, Gold discloses this feature (see Figures 1a and 1b). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Hori and Shanahan with a method of providing a partial part of the digital data file to be transmitted, wherein the partial part is a beginning part of the digital data as taught by Gold. This modification would have improved the system's user friendliness by allowing the user to ensure the dedicated song is the one the sender wanted as suggested by Gold (see column 5).

Response to Arguments

8. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Allowable Subject Matter

9. Claim 21 is allowed because neither Hori nor Rolf disclose transmitting the selected compressed digital data file and the telephone number of the second mobile terminal for storage in a second server different from the first server, if the second mobile terminal is determined not to be in a state of being available for receiving the digital data file.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

OA

Olisa Anwah
Patent Examiner
April 13, 2007


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